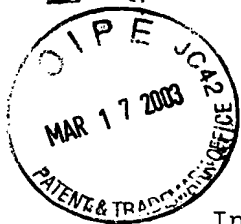


9/3M
3-19-03



Atty. Docket: IP-6084

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Wadood Hamad et al. : Group Art Unit: 1731
Serial No.: 09/838,463 : Examiner: Alvo, M.S.
Filed: April 19, 2001
Title: METHOD FOR MANUFACTURING PAPER AND
PAPERBOARD USING FRACTURE TOUGHNESS
MEASUREMENT

Commissioner of Patents & Trademarks
Washington, D.C. 20231

AMENDMENT AFTER FINAL REJECTION

RECEIVED
MAR 18 2003
TC 1100 MAIL ROOM

DO NOT ENTER
OK TO ENTER
OK AS ENTERED

In response to the Office Action dated December 30, 2003 in the above-referenced patent application, the Applicants submit the following argument.

ARGUMENT

This application has already seen three office actions addressing the merits of the claims.

In the first Office Action dated December 12, 2001, claims 10, 11, 13-15, 17, 19, 20 and 23 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,013,403 to Chase in view of U.S. Patent No. 5,036,696 to Ahrens et al.; claims 12, 16, 18, 21 and 24 were rejected as being obvious over Chase in view of Ahrens and further in view of U.S. Patent No. 3,490,689 to Hart et al.; and claim 22 was rejected as being obvious over Chase in view of Ahrens, and further in view of the article by Page et al.

On March 18, 2002, the Applicants filed an Amendment in response to the December 22, 2001 action. In addition to a claim amendment, the Applicants presented arguments traversing the prior art grounds for rejection.

New grounds for rejection were presented in the Office Action dated June 12, 2002. Claims 10, 11, 13-15, 17, 19, 20 and 23 were now rejected under 35 U.S.C. § 103(a) as being obvious over Chase in view of any of three articles by Seth; claims 12, 16, 18, 21 and 24 were rejected as being obvious over Chase in view of Seth, and further in view of Hart; and claim 22 was rejected as being obvious over Chase in view of Seth, and further in view of the article by Page et al. In addition, the Examiner refuted Applicants' arguments made in the Amendment filed on March 18, 2002.

In response to the June 12, 2002 Office Action, the Applicants submitted an Amendment on October 22, 2002. In that response, arguments traversing the new grounds for rejection were presented. In particular, the Applicants set forth the three basic criteria for establishing a *prima facie* case of obviousness as set forth at MPEP 706.02(j), to wit, (1) some suggestion or motivation in the prior art to modify the reference or to combine reference teachings; (2) a reasonable expectation of success; and (3) the combined prior art references must teach or suggest all of the claim limitations. The Applicants applied these criteria to show that the

Examiner had failed to establish a *prima facie* case of obviousness.

In the latest Office Action, the Examiner has repeated verbatim all grounds for rejection asserted in the June 12, 2002 Office Action, including the rejection of claims 16 and 24, which are merely objected to in the Office Action Summary. Thus, the text of the office action is inconsistent with the Office Action Summary.

Moreover, the latest Office Action incorporates verbatim, not only the same grounds for rejection, but also all of the rebuttals to Applicants' arguments presented in the March 18, 2002 Amendment. For example, the Examiner on page 3 of the latest action states that Applicants' argument that Ahrens and Chase are not combinable was moot. But Applicant presented this argument in the March 18, 2002 Amendment, not in the October 22, 2002 Amendment. The Examiner has not discussed or addressed a single argument made by the Applicants in the October 22, 2002 Amendment.

Section 707.07(f) of the MPEP states:

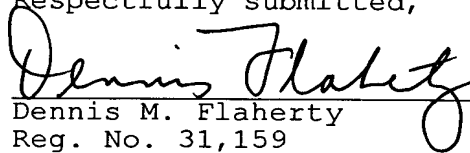
Where the Applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

The examiner has not followed this rule. Instead the examiner has repeated each rejection without answering any of Applicants' arguments why the rejections are mistaken. Thus,

the latest Office Action is improper and contrary to the rules of patent examining procedure.

The Applicants respectfully request that the Final Rejection be withdrawn and that a new action addressing the substance of Applicants' October 22, 2002 arguments be issued.

Respectfully submitted,



Dennis M. Flaherty
Reg. No. 31,159
Ostrager Chong & Flaherty LLP
825 Third Avenue, 30th Floor
New York, NY 10022-7519
Tel. No.: 212-826-6565

March 11, 2003
Date

CERTIFICATE OF MAILING

The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on the date set forth below.

March 11, 2003
Date


Dennis M. Flaherty

AF
1700

Atty Docket No.: IP-6084

Applicants: Wadood Hamad et al.

Group Art Unit: 1731

Serial No.: 09/838,463

Examiner: Alvo, M.S.

Filed: April 19, 2001

Date: March 11, 2003

Title: METHOD FOR MANUFACTURING PAPER
AND PAPERBOARD USING FRACTURE
TOUGHNESS MEASUREMENT

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

RECEIVED
MAR 18 2003
TC 1700 MAIL ROOM



TRANSMITTAL LETTER

Sir:

Transmitted herewith for filing in the above-identified application is an Amendment After Final Rejection.

FEE FOR ADDITIONAL CLAIMS

☒ A fee for additional claims is not required.

☐ A fee for additional claims is required. The additional fee has been calculated as shown below:

| | CLAIMS REMAINING AFTER AMENDMENT | | HIGHEST NUMBER PREVIOUSLY PAID FOR | | NUMBER OF EXTRA CLAIMS | RATE | ADDITIONAL FEE |
|--|---|---|---|---|------------------------------|-----------|-------------------|
| TOTAL CLAIMS: | 15 | - | 24 | = | 0 | x \$18 = | 0 |
| INDEPENDENT CLAIMS: | 3 | - | 4 | = | 0 | x \$84 = | 0 |
| FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM | | | | | | + \$280 = | 0 |
| TOTAL FEE DUE \$ | | | | | | | 0 |

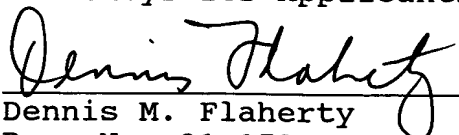
☐ Our check for payment of the required fee for a one-month extension of time, in the amount of \$_____, is enclosed.

☐ Please charge \$_____ to Deposit Account No. 15-0699 in payment of the fee.

☒ The Commissioner is authorized to charge payment of any extension or other fee under 37 CFR 1.16 or 1.17 which may be required by this paper or credit any overpayment of same to Deposit Account No. 15-0699.

Respectfully submitted,

Attorneys for Applicants


Dennis M. Flaherty
Reg. No. 31,159
Ostrager Chong & Flaherty LLP
825 Third Avenue, 30th Floor
New York, NY 10022-7519
(212) 826-6565